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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/083,681	05/22/98	WOJCIK	C 648953489

LM71/0917  
MASON FENWICK & LAWRENCE  
1225 EYE STREET NW SUITE 1000  
WASHINGTON DC 20005

EXAMINER

IRSHADULLAH, M

ART UNIT	PAPER NUMBER
2765	4

DATE MAILED: 09/17/99

*restated*

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks



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MASON FENWICK & LAWRENCE  
1225 EYE STREET NW SUITE 1000  
WASHINGTON DC 20005

LM02/0818

EXAMINER

IRSHADULLAH, M

ART UNIT	PAPER NUMBER
2765	

DATE MAILED: 08/18/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/083,681

Applicant(s)  
Wojcik et al.

Examiner  
M. Irshadullah

Group Art Unit  
2765



Responsive to communication(s) filed on May 22, 1998

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

### Disposition of Claims

Claim(s) 9-18 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 9-18 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 3

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## DETAILED ACTION

### *Priority*

1. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification (37 CFR 1.78).

### *Specification*

2. The disclosure is objected to because of the following informalities:

Page 15, line 22: " 1a " should be " 1b ";

Page 29, line 8: " 352 " should be " 356 ";

Page 39, line 6: " Bill of Lading " should be " Bill of Landing ( BOL )", similar spelling corrections for " Lading " in the next line and other places be done;

Page 40, line 25: " ( 178 ) " should be " ( 400 ) ";

Page 42, line 2 " ( 422 ) " should be " ( 426 ) " and line 20: " (10) " should be " ( 448 ) ";

Other spelling and editorial corrections are needed throughout the specification.

Appropriate corrections are appreciably required for the benefit of the patent community

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***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 9-16 are rejected under 35 U.S.C. 112, second paragraph, as being vague/indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A) Claim 9 preamble recites “ A method for creating an electronic catalog ”, but claim steps fail to achieve the same.

B) Claim 10 preamble recites “ A system for processing customer orders ”, whereas claim steps culminate into “ means for creating an electronic catalog ”.

Hence, claims 9 and 10 are rejected as being vague/indefinite under U.S.C. 112, Second paragraph. Claims 11-16 being dependent from claim 10 are rejected on the same grounds.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shavit et al ( US Patent 4,799,156 ).

Shavit et al discloses:

- Claim 9.** A method for creating an electronic catalog [ Col 1, lines 62-64 recited with col 12, lines 58-59 ] comprising the steps of:
- a) requesting a vendor quotation [ Col 7, lines 56-57 read with col 1, lines 10-12 ];
  - b) creating blanket vendor order [ Col 12, lines 60-61 and claim 8, lines 65-66 ];
  - c) entering the blanket vendor order in a data base [ Col 12, lines 58, 60-61 and 57 ];
  - e) creating purchase request [ Col 13, lines 51-52 ];
  - f) requesting an item from the blanket vendor order data base using the purchase request [ Col 12, lines 65-68 continue col 13, lines 1, 51-52 and col 12, line 54 ];
  - g) communicating said order from the vendor order data base to a vendor [ Abstract, lines 6-9, col 13, lines 1, 51-52 and col 12, line 54 ];
  - h) receiving acknowledgment of the communicated order [ Col 1, lines 34-36 and col 12, line 61 ];
  - i) receiving the ordered item [ Fig. 3 ( 124 ) and col 13, line 1 ]; and
  - j) recording receipt of said item [ Col 15, lines 48-49 and col 13, line 1 ];

Shavit et al fail to teach the following step:

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Shavit et al fail to teach the following step:

d) creating a pre-approved budget;

Official notice is taken that the feature is an old and well known practice in business/marketing art. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the feature in Shavit et al's invention, because the feature is a basic and essential requirement of any business/organization/institution, so spending limits could be known and maintained by the personnel involved.

8. Claims 10-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roach et al ( US Patent 5,434,394 ) in view of Shavit et al ( US Patent 4,799,156 ).

Roach et al show:

**Claim 10.** A system for processing customer orders [ Claim 1, lines 2-3 ],

comprising:

a) means for purchasing an item [ Fig. 4b ( 402 ) described col 13, lines 12-18 ];

b) means for creating a graphical user interface [ Figs. 4a-4e and 5 ] for a customer service input an order [ Col 9, lines 18-30 ( specifically lines 18-22 and 27-28 ) ];

c) means for tendering a load to a carrier for shipment [ Fig. 4c ( 404 ), col 2, lines 19-21 and Fig. 6 ( 614 ) ];

d) means for creating an automated warehousing ticket [ Col 4, lines 42-43 ]; and

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Roach et al do not teach the undernoted feature:

e) means for creating an electronic catalog.

However, Shavit et al show the same [ Col 1, lines 61-68 ( specifically lines 62-63 ), Fig. 2 and Fig. 24 ( 644 ) described col 33, lines 63-64 ]. It would have been obvious to one of ordinary skill in the marketing art at the time of applicant's invention to include Shavit et al's feature in Roach et al's invention, because it would facilitate consolidated marketplace information about and to efficiently conduct business with a variety of vendors/suppliers/service providers at one database/catalogue.

In the following claim Roach et al fail to show all the features excepting d):

**Claim 11.** The system of claim 10, wherein the means for purchasing an item further comprises:

d) means for communicating a purchase request and a purchase release to a vendor [ Fig. 1 ( 34 ), col 4, line 64 and col 10, lines 17-22 ( specifically ( line 20 ) );

However, Shavit et al teach:

a) means for creating a blanket vendor order [ Shavit et al: Col 12, lines 60-61 and claim 8, lines 65-66 ];

b) means for providing user input to generate a requisition request to requisition the item [ Shavit et al: Col 13, lines 51-52 ];



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c) means for processing the requisition request by comparing said requisition request to the blanket vendor order to determine availability of the item [ Shavit et al: Col 2, lines 60-65 ( specifically line 61 ) and col 10, lines 65-68 ]; and

e) means for acknowledging the purchase request [ Shavit et al: Col 1, lines 34-36 and col 12, line 61 ];

It would have been obvious to one of ordinary skill in the marketing art at the time of instant invention to include Shavit et al's features into Roach et al's invention, because the same would facilitate purchaser to provide consolidated marketplace information about and to efficiently conduct business with a variety of vendors/suppliers/service providers.

Both Shavit et al and Roach et al fail to teach the following feature:

means for checking the availability of funds against a budget to approve a purchase transaction.

Official notice is taken that the forementioned feature is old and well practice in the business and marketing art. It would have been obvious to one of ordinary skill in the art at the time of instant invention to incorporate the feature into Shavit et al's invention as combined with Roach et al's, because the feature is a basic and essential requirement of any business/organization/institution, so spending limits could be known and maintained by the personnel involved.

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Roach et al do not disclose the features in the understated claim:

**Claim 12.** The system of claim 11, wherein the means for purchasing an item further comprises:

However, Shavit et al teach the same:

means for receiving the item [ Shavit et al: Fig. 3 ( 124 ) and col 13, line 1 ];

means for creating a record of the receipt [ Shavit et al: Col 15, lines 48-49 and col 13, line 1 ];

means for creating an accounts payable record initiated by said record of receipt [ Shavit et al: Fig. 14 ( 310, 314 ) and Fig. 15 ( 344 ) ]; and

means for placing the item in an inventory [ Shavit et al: Col 17, lines 56-57 ].

It would have been obvious to one of ordinary skill in the art at the time of current invention to incorporate Shavit et al's features into Roach et al's invention, because it would provide a comprehensive system that would facilitate efficiency and would save time.

**Claim 13.** The system of claim 10, wherein the means for creating a graphical user interface for a customer service representative, further comprises:

means for creating screens in a window context with multiple files, said screens having buttons to control access to files, wherein said buttons are used to access customer records [ Roach et al: Figs. 4a-4e, 5, 8a and 8b ].

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Roach et al fail to show the features in the following claim, however, Shavit et al teach:

**Claim 14.** The system of claim 10, wherein the means for tendering a load to a carrier for shipment further comprises:

means for creating a carrier data base containing information to determine shipping costs and delivery schedules [ Shavit et al: Fig. 2 ( 86 ), col 36, line 46 and lines 23-49 ];

means for tendering an offer of shipment to a selected carrier [ Shavit et al: Fig. 33 and col 36, lines 31-49 ( specifically lines 47-49 ) ]; and

means for receiving confirmation from the carrier [ Shavit et al: Col 6, lines 60-62 ].

It would have been obvious to one of ordinary skill in the marketing art at the time of applicant's invention to include Shavit et al's features into Roach et al invention, because shipping is an integral part of an on-line business and inclusion of carrier information would provide an all-in-one system.

**Claim 15.** The system of claim 10, wherein the means for creating an automated warehousing ticket [ Roach et al: Col 4, lines 42-43 ] further comprises:

means for generating pick-order data for an item [ Roach et al: Col 2, lines 40-41 ];

means for picking the item from an inventory [ Roach et al: Col 10, lines 17-19, 32-34 ];

means for creating a record of the picked item [ Roach et al: Col 10, lines 28-31 ];

means for transmitting said pick-order data to a central data base in real time [ Roach et al: Fig. 1 ( 16, 40 to 52 ) and col 2, line 61 ];

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means for delivering the picked item to a shipping point [ Roach et al: Col 2, lines 15-17 and Fig. 6 ( 614 ) ];

means for transmitting data representing delivery of the item for shipment to said data base [ Roach et al: Col 2, lines 9-17 and Fig. 1 ( 52 ) ]; and

means for consolidating said pick-order and shipment data into a record in said database [ Roach et al: Col 2, lines 56-59 and Fig. 1 ( 52 ) ].

Roach et al do not teach the features in the undernoted claim, however, Shavit et al teach all the features except “ means for creating a pre-approved budget ” ;

**Claim 16.** The system of claim 10, wherein the means for creating an electronic catalog further comprises:

means for requesting a vendor quotation [Col 7, lines 56-57 read with col 1, lines 10-12] ;

means for creating a blanket vendor order [ Col 12, lines 60-61 and claim 8, lines 65-66 ];

means for entering said blanket vendor order into a blanket order data base [ Col 12, lines 58, 60-61 and 57 ];

means for creating a purchase request [ Col 13, lines 51-52 ];

means for requesting an item from the blanket vendor order data base [ Col 12, lines 65-68 continue col 13, lines 1, 51-52 and col 12, line 54 ];

means for communicating said blanket order to a vendor [ Abstract, lines 6-9, col 13, lines 1, 51-52 and col 12, line 54 ];

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means for receiving acknowledgment of a blanket order request [ Col 1, lines 34-36 and col 12, line 61 ];

means for receiving said ordered item [ Fig. 3 ( 124 ) and col 13, line 1 ]; and

means for recording receipt of said item [ Col 15, lines 48-49 and col 13, line 1 ].

It would have been obvious to one of ordinary skill in the marketing art at the time of applicant's invention to include Shavit et al's features in Roach et al's invention, because the same would facilitate consolidated marketplace information about and to efficiently conduct business with a variety of vendors/suppliers/service providers at one database/catalogue.

Both Shavit et al and Roach et al fail to teach the following feature:

means for creating a pre-approved budget.

Official notice is taken that the forementioned feature is old and well practice in the business and marketing art. It would have been obvious to one of ordinary skill in the art at the time of instant invention to incorporate the feature into Shavit et al's invention as combined with Roach et al's, because the feature is a basic and essential requirement of any business/organization/institution, so spending limits could be known and maintained by the personnel involved.

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### *Double Patenting*

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

10. Claims 17 and 18 are rejected under the judicially created doctrine of double patenting over claims 1 and 2 of U. S. Patent No. 5,666,493 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

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Application:

Patent:

**Claim 17.** A method for processing customer orders in a computer-based data processing system having a plurality of data processing devices electrically connected to communicate with each other, comprising:

Claim 1 preamble;

receiving a customer order from a customer order input terminal;

Claim 1, lines 51-52;

processing the customer order using an interface module accessed through the customer order input terminal, said interface module coordinating access to a plurality of database modules and controlling interaction between a user and said plurality of database modules;

Claim 1, lines 54-60;

generating the customer- order in response to data inputs from the user through said customer order input terminal and data from said plurality of database modules;

Claim 1, lines 61-64;

automatically checking an inventory for availability of an item corresponding to the customer order in response to the customer order by accessing an inventory data base;

Claim 1, lines 65-66 and col 21, lines 1-4;

retrieving the item from the inventory by accessing

Claim 1, col 21, lines 5-8;

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an inventory storage location data base;

building a load for shipment from the retrieved Claim 1, col 21, lines 12-14;

item; and

scheduling delivery of the load to the customer. Claim 1, col 21, lines 18-19.

**Claim 18.** A method for processing a customer order Claim 2 preamble;

using a networked computer-based data processing

system, comprising:

receiving a customer order from a customer order Claim 2, lines 31-33;

input terminal;

processing the received customer order to generate Claim 2, lines 34-35 continue col 22,

a customer order in response to data inputs from a user; lines 1-2;

automatically checking an inventory for availability Claim 2, col 22, lines 3-7;

of an item corresponding to the customer order by accessing

an inventory data base;

retrieving the item by accessing an inventory storage Claim 2, col 22, lines 8-12;

location data base;

building a load for shipment containing the retrieved Claim 2, col 22, lines 13-15;

item; and

scheduling the load for delivery to the customer. Claim 2, col 22, lines 19-20.



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*Conclusion*

11. The prior art and other material made of record and not relied upon is considered pertinent to applicant's disclosure.

a) Povilus, US Patent 5,740,425. Data Structure And Method For Publishing Electronic And Printed Product Catalogs.

b) Westrope et al., US Patent 5,721,832. Method And Apparatus For An Interactive Computerized Catalog System.

c) Hill, US Patent 5,761,649.

d) King, Jr. et al., US Patent 5,319,542. System For Ordering Items Using An Electronic Catalogue.

e) Sellers et al., US Patent 5,311,438. Integrated Manufacturing System.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Irshadullah whose telephone number is (703) 308-6683.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allen MacDonald, can be reached on (703) 305-9708. The fax number for the organization is (703) 305-0040.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-3900.



M. Irshadullah

August 05, 1999



ERIC W. STAMBER  
PRIMARY EXAMINER